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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/701,453    04/16/01    GRANDOFF

D    CHIR-0283

EXAMINER

HM12/0828

ALISA A HARBIN  
CHIRON CORPORATION  
INTELLECTUAL PROPERTY    R338  
PO BOX 8097  
EMERYVILLE CA 94662

FIELD NO. 1

ART UNIT

PAPER NUMBER

1645

DATE MAILED:

08/28/01

*9*

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trad marks**

# Office Action Summary

Application No.

09/701,453

Applicant(s)

GRANOFF ET AL.

Examiner

Iesha P Fields

Art Unit

1645

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☐ Claim(s) \_\_\_\_ is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: \_\_\_\_\_.

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### **DETAILED ACTION**

Applicant's Preliminary Amendment filed August 3, 2001 (Paper No. 8) has been received and entered. Claims 15 and 16 were amended consequently, Claims 1-16 are pending in the instant application.

#### ***Priority***

Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d) to PCT Application No. US99/11977, filed on May 5, 1999.

#### ***Drawings***

This application has been filed with informal drawings which are acceptable for examination purposes only. Formal drawings will be required when the application is allowed.

#### ***Claim Rejections - 35 USC § 112***

1. Claims 1 and 15 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a making immunogenic composition, it does not reasonably provide enablement for making a "vaccine". The specification provides insufficient guidance of how to use the claimed species as a vaccine. It is well recognized in the art that it is unclear whether a single protein derived from a pathogen

will elicit protective immunity. Ellis, R.W. (see Chapter 29 of "VACCINES" [Plotkin, S.A. et al., (ed.), published by W.B. Saunders Company (Philadelphia) in 1988, especially page 571, 2<sup>nd</sup> full paragraph] exemplifies this problem in the recitation that "The key to the problem (of vaccine development) is the identification of that protein component of a virus or microbial pathogen that itself can elicit the production of protective antibodies... and thus protect the host against attack by the pathogen." Since no working examples are set forth in the specification that the claimed species are useful for vaccination and the art teaches of the unpredictability of using a single antigen for vaccination it would be an undue burden and be unpredictable to use the broadly claimed product for vaccination.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

#### **2. Claims 1-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Anderson and Porro et al.**

The claims are drawn to an immunogenic composition comprising an oligosaccharide conjugated to a carrier and an outer membrane protein.

Anderson (US Patent 4,673,574) discloses an immunogenic composition comprising an oligosaccharide conjugated to a carrier and an outer membrane protein. Anderson further discloses an immunogenic composition wherein the carrier is CRM<sub>197</sub> (See Entire Document). Anderson further discloses that the immunogenic composition comprises an aluminum adjuvant (See especially Example 8).

Porro et al. (US Patent 5,153,312) disclose a method of making an immunogenic composition comprising an oligosaccharide conjugated to a carrier and an outer membrane protein. Porro et al. further disclose that the composition may be used in vaccine preparations (See Entire Document).

### ***Status of the Claims***

#### **3. No claims are allowed.**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Iesha P Fields whose telephone number is (703) 605-1208. The examiner can normally be reached on 7am-3:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynette Smith can be reached on (703) 308-3909. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3014 for regular communications and (703) 308-4242 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

Ilesha Fields

August 24, 2001



MARK NAVARRO  
PRIMARY EXAMINER